

As a preliminary matter, Claims 8 and 13 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Applicants added new claim 15 which includes the elements of independent Claim 1 and dependent Claim 8. Therefore, new independent Claim 15 and Claims 16-24, which depend from Claim 15, are believed to be in condition for allowance. Similarly, Applicants added new Claim 25, which includes the elements of independent Claim 12 and dependent Claim 13. Therefore, Applicants believe that new Claim 25 is now in condition for allowance.

Claims 1, 3, 4 and 9 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 2002/0078559A1 to Buchwalter et al. ("*Buchwalter*"). Applicants respectfully submit that *Buchwalter* is not a proper prior art reference with respect to the claimed invention and therefore cannot anticipate the claimed invention. Specifically, 35 U.S.C. § 102(e) states that a person shall be entitled to a patent unless the invention of the patent was described in "an application for patent, published under § 122(b), by another filed in the United States before the invention by the applicant for patent . . ." (emphasis added). Applicant may be able "to overcome the 35 U.S.C. § 102(e) rejection by proving he or she is entitled to his or her own 35 U.S.C. § 119 priority date which is earlier than the references U.S. filing date." See MPEP § 2136.03. The present application claims foreign priority under 35 U.S.C. § 119 to an earlier filed Japanese Patent Application No. P2000-380944, which was filed on December 14, 2000. The effective U.S. filing date of *Buchwalter* is December 27, 2000. Because the earliest effective filing date of the present application is earlier than the earliest effective U.S. filing date of *Buchwalter*, *Buchwalter* is not prior art which can be cited against the present application. For these reasons, Applicants respectfully request that the rejection under § 102(e) based on *Buchwalter* be withdrawn.

Claims 1, 3, 4 and 5 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,929,962 to Kelly et al. ("*Kelly*"). Applicants submit that *Kelly* does not disclose all of the elements in Claims 1, 3, 4 and 5. Therefore, Applicants respectfully request that the patentability of these claims be reconsidered for the following reasons.

At the outset, Applicants respectfully note that the U.S. patent number cited for *Kelly* in the Office Action (i.e., U.S. Patent No. 5,929,962) is not the correct patent number for this

reference. The correct patent number for *Kelly* is U.S. Patent No. 6,036,809. Applicants believe that the patent number was in error and therefore, Applicants will respond to this rejection in view of *Kelly*.

*Kelly* discloses a process for fabricating or releasing a thin film structure from a primary carrier such as a substrate. The Patent Office contends that *Kelly* discloses “a method comprising the steps of selectively laser ablating a separation layer in order to separate a layer which is attached to a temporary substrate.” *Kelly* does not disclose, however, a method for “irradiating, selectively, an interface between a first substrate and a device included on the first substrate with an energy beam and transmitting the energy beam through the first substrate to selectively release the device.” See Claim 1. In *Kelly*, a thin film structure is removed from carrier 10 by laser ablating a polyimide 15. As shown in Fig. 5, a scanning layer is directed through the perimeter of the multi-layer thin film structure in the metal-inter layer 20 and into the polyimide 15. A scanning laser is not directed through the active areas or devices 48. See Col. 7, lines 55-67. Specifically, the laser, as shown by arrow 60 in Fig. 6, is laser ablating the edges or perimeter of metal-inter layer 20 to separate that layer from the polyimide 15. Therefore, *Kelly* does not disclose, or even suggest, irradiating the interface between a substrate and a device to release the device from the substrate. In fact, *Kelly* specifically teaches away from irradiating the device or active areas 48 or even the interface between the active areas and a substrate. See Col. 7, lines 59-67. Thus, *Kelly* does not disclose “irradiating, selectively, an interface between a first substrate and device” or “transmitting the energy beam through the first substrate to selectively release the device” as in the claimed invention. For all these reasons, Applicants submit that independent Claim 1 and Claims 3, 4 and 9 which depend from Claim 1, are patentable over the art of record.

Claims 2, 5, 6 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Buchwalter* in view of U.S. Patent No. 6,420,242 B1 to Cheung et al. (“*Cheung*”). As described above, *Buchwalter* is not a proper prior art reference based on its filing date with respect to the filing date of the present application. Moreover, *Cheung* does not disclose or suggest all of the elements of the claimed invention. Therefore, Applicants respectfully request that the rejection of these claims under § 103 be withdrawn.

*Cheung* discloses a method of separating thin films from transparent substrates by

selective optical processing. *See* the title. *Cheung* does not disclose or suggest selectively irradiating an interface between a first substrate and a device with an energy beam and transmitting the energy beam through the first substrate to selectively release the device from the substrate as in the claimed invention. Claims 2, 5, 6 and 7 depend from independent Claim 1. Therefore, Applicants respectfully submit that Claims 2, 5, 6 and 7 are allowable for at least the reason set forth above with respect to independent Claim 1, and for the further reasons that *Buchwalter* is not a proper prior art reference and *Cheung* does not disclose or suggest all of the elements of these claims. Thus, Applicants respectfully submit that Claims 2, 5, 6 and 7 are patentable over the art of record.

Claims 11, 12 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Buchwalter* in view of U.S. Patent No. 5,929,962 to Chiu et al. ("*Chiu*") and in further view of U.S. Patent No. 4,451,634 to Hatanaka et al. ("*Hatanaka*"). Applicants submit that the combination of *Buchwalter*, *Chiu* and *Hatanaka* does not teach or suggest all of the elements of Claims 11, 12 and 14.

*Buchwalter* is not a proper prior art reference as described above. Furthermore, the combination of *Chiu* in view of *Hatanaka* does not disclose or suggest all of the elements of Claims 11, 12 and 14. For all these reasons, Applicants submit that Claims 11, 12 and 14 are patentable over the art of record.

Additionally, new Claims 26-35 were added to the application. The cited prior art references do not disclose, teach or suggest "irradiating, selectively, an interface between a first substrate and a device included on the first substrate with an energy beam to selectively release the device," "transferring the released device onto a device holding layer" and "cleaning the device on the device holding layer." Therefore, Claims 26-35 are believed to be allowable in view of the prior art.

In light of the above, Applicants respectfully submit that Claims 1-7, 9-12, 14 and 15-25 are novel and nonobvious over the art of record because the cited references, either alone or in combination, do not disclose, teach or suggest the claimed invention. Accordingly, Applicants respectfully request that Claims 1-7, 9-12, 14 and 15-25 be deemed allowable at this time and that a timely notice of allowance be issued in this case.

Attached hereto is a marked-up version of the changes made to the specification and

claims by the current amendment. The attached page is captioned "**Versions with Markings to Show Changes Made.**"

A check in the amount of **\$486** has been submitted to cover the fees for any additional claims added to the application by this Response. If any other fees are due in connection with this application as a whole, the Patent Office is authorized to deduct such fees from Deposit Account 02-1818. If such a withdrawal is made, please indicate the attorney docket number (112857-306) on the account statement.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Chris Hermanson", written over a horizontal line.

Christopher S. Hermanson (Reg. No. 48,244)  
Bell, Boyd & Lloyd LLC  
P.O. Box 1135  
Chicago, Illinois 60690-1135  
(312) 807-4225  
Attorney for Applicant

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**Version with Markings to Show Changes Made**

**In the Claims:**

Claim 8 has been canceled without prejudice.

Claim 13 has been canceled without prejudice.

New Claims 15-35 have been added.